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18M1/0107

EXAMINER

SCHEINER, L

ART UNIT

PAPER NUMBER

1813

47

01/07/97

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 6/11/96 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 8, 9, 35-52 are pending in the application.

Of the above, claims 36, 42, 43, 48 & 52 are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 8, 9, 35, 37-41, 44-47 & 49-51 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

This application contains claims directed to the following patentably distinct species of the claimed invention:

1. the full-length PM-1 DNA coding region;
2. fragments of the nucleic acids which encode PM-1;

Each species is distinct in that each comprises a distinct amino acid or nucleotide sequence. Accordingly, prior art searches for each species are not coextensive.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 8, 9, 37-41, 44, 45, 47, 49, and 51 are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

During a telephone conversation with Jean Silveri on June 12, 1996, a provisional election was made with traverse to prosecute the invention of Group II, claims 8, 9, and 35-52, applicants also elected the species of the full-length nucleic acid sequence which encodes PM-1. Affirmation of this election must be made by applicant in responding to this Office action. At this time, claims 36, 42, 43, 48, and 52 are withdrawn as not reading on the elected species. Accordingly, claims 8, 9, 35, 37-41, 44-47, and 49-51 read on the elected species. At this time, generic claims from this group will be read with the limitations of the elected species only, i.e. the nucleic acid will be read as the full length DNA which encodes the protein having the sequence of SEQ ID NO:1.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Sequence rule 1.821 requires the use of SEQ ID NO even if the sequence is embedded in the text or in the claims. All sequences must be referred to by use of an identifier such as "SEQ ID NO" as presented in the Sequence Listing even though the sequence itself may be imbedded in the text of the application.

The disclosure and/or claims of the application mention a sequence that is set forth in the Sequence Listing but reference is not properly made to the sequence by the use of a sequence identifier in the art.

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As set forth above, claims 8, 9, 37-41, 44, 45, 47, 49, and 51 are read with the limitations of the elected species only. Accordingly, rejections directed to the recitation of "fragments", "functional equivalent", "modified", etc. are held in abeyance until such time that the elected species is found allowable.

Claims 8, 9, 35, 37-41, 44-47, and 49-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As set forth above, the claims should make specific reference to SEQ ID NO:1, rather than "shown in the Sequence Listing" since SEQ ID NO:2 does not set forth a nucleic acid sequence.

The claims are free of the prior art insofar as said claims are read with a limitation drawn to a nucleotide sequence as set forth in SEQ ID NO:1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Scheiner whose telephone number is (703) 308-1122.

Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is (703) 305-7939.


Laurie Scheiner/LAS
December 26, 1996


LAURIE A. SCHEINER
PATENT EXAMINER
GROUP 1800